

DESIGN PATENT PERSPECTIVE: The Design Patent Application PART 4



BY ROBERT G. OAKE, JR.

Robert G. Oake, Jr. specializes in design patent litigation. He is a registered patent attorney and is board certified as a civil trial advocate by the

National Board of Trial Advocacy. Robert earned a master of laws degree in patent and intellectual property law (with highest honors) from The George Washington School of Law, a general master of laws with concentrations in international business and technology transfer law from the SMU School of Law, and a J.D. from South Texas College of Law, where he was school moot court champion his first year and state moot court champion his third year.

*Robert served as lead trial and appellate counsel for Egyptian Goddess, Inc. in *Egyptian Goddess v. Swisa* (en banc). Robert maintains legal websites at www.oake.com and www.designpatentschool.com. He may be contacted at rgo@oake.com.*

This month we tackle the oath (or declaration) and fees. These two final matters, together with the previously discussed title, figure descriptions, claim, and drawings, make up the mandatory elements of a basic design patent application.

OATH OR DECLARATION

Inventor oaths and declarations are not required by the U.S. Constitution, but Congress long has believed that such oaths/declarations help enforce the constitutional principle that only “Inventors” receive “the exclusive Right to their ... Discoveries.”¹ Since Congress created the oath/declaration requirement, Congress can modify the details within constitutional parameters, and has done so throughout the years.²

Changes in the oath/declaration reflect changing perspectives on what an inventor must swear to or declare when applying for a patent.³ Changes also help oath/

declaration requirements adjust to related and evolving laws. The latest changes in the oath/declaration requirement became effective September 16, 2012 as part of section 4 of the Leahy-Smith American Invents Act (AIA).⁴ The amendments in AIA section 4 apply to any patent application filed on or after September 16, 2012.⁵ The final rules implementing the new oath/declaration requirements were published on August 14, 2012 following public comment and extensive revision.⁶

At its core, the AIA transforms the American patent system from a “first to invent” system to a “first inventor to file” system. The change is an effort to harmonize the American system with other “first to file” patent systems, while respecting the U.S. Constitution’s requirement that only “inventors” receive protection.⁷ The AIA also makes sweeping changes in the ability of an assignee to file a patent application as the applicant,⁸ and does so to the degree that the patent system might now be more appropriately described as a “first inventor/assignee to file” system.

Under the AIA, the filing date becomes critically important, and the switch to “first inventor to file” places a new emphasis on speed and efficiency when filing a patent application. Changes in the oath/declaration reflect this new emphasis and include the following: 1) content changes; 2) substitute statements; 3) application data sheets; 4) assignments; 5) timing; and 6) reissues. Major changes in these six categories are discussed below.

CONTENT CHANGES

The new oath/declaration is shorter and simpler than the old one. Inventors now need only 1) identify themselves by legal name (rather than by full name),⁹ 2) identify the related patent application,¹⁰ 3) state their belief that they are “the original inventor or an original joint inventor of a claimed invention in the application,”¹¹ 4) state the application was made or authorized to be made by the person executing the oath/declaration,¹² and 5) acknowledge that “any willful false statement made in such declaration or statement is punishable

under 18 USC § 1001 by fine or imprisonment of not more than five years, or both.”¹³ Additionally, if an application data sheet is filed that identifies the legal name and address of all joint inventors, this information need not be provided in the oath/declaration.¹⁴

The new oath/declaration no longer requires inventors to swear they believe they are the “first” inventor (reflecting the change to a “first inventor to file” system), to state their country of citizenship, or to provide their full name (only legal names are required).¹⁵ Further, the new oath cannot include a claim for foreign priority and such claims now must be made in an application data sheet.¹⁶

Also no longer required are express statements that the inventor (1) reviewed and understands the application including the claims and (2) acknowledges the duty to disclose all information known to be material to patentability.¹⁷ Instead, the new rules provide that anyone signing an oath must have reviewed and understood the application including the claims and must be aware of the duty to disclose.¹⁸ So the “review and understand” and “duty to disclose” requirements still exist, but they are in the rules instead of the oath itself. Note that a legal representative would be wise to document that the inventor was advised of these legal requirements.

Finally, 37 CFR 1.63 (“oath or declaration”) now expressly authorizes use of declarations in place of oaths. Declarations formerly were authorized by a reference in section 1.63(a)(1) to 37 CFR 1.68 (“Declaration in lieu of oath”).¹⁹ As a result of the change, declarations now need not include the section 1.68 statements that “willful false statements and the like ... may jeopardize the validity of the application or any patent issuing thereon” and “all statements made of the declarant’s own knowledge are true and that all statements made on information and belief are believed to be true.” The only declaration penalty statement now required is that “willful false statement made in such declaration or statement is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.”²⁰

The patent office provides forms for both the old and new oath/declarations.²¹ The forms are not mandatory, but they are strongly recommended.²² If you choose to use your own forms, be careful because

even small changes can cause the oath/declaration to be rejected.

SUBSTITUTE STATEMENTS

At times an inventor oath or declaration cannot be obtained because the inventor is deceased, under legal incapacity, cannot be found, or refuses to sign. The procedure for dealing with these situations has been simplified under the AIA. Under revised 37 CFR 1.64, if an inventor oath/declaration cannot be obtained, an applicant under 37 CFR 1.43 (deceased or legally incapacitated inventor), 1.45 (joint inventors), or 1.46 (assignee, obligated assignee, or a person who otherwise shows sufficient proprietary interest in the matter) may execute a substitute statement in lieu of an oath or declaration. Gone is the need to submit a petition with proof of pertinent facts under 37 CFR 1.47.²³

The requirements of a substitute statement are set forth in 37 CFR 1.64(b). An applicant must 1) identify the inventor or joint inventor, 2) state upon information and belief the facts the inventor is required to state, 3) identify the person executing the substitute statement and their relationship to the inventor, and 4) identify the circumstances permitting the person to execute the substitute statement.²⁴ Additionally, unless such information is provided in an application data sheet, an applicant must provide 1) the residence and mailing address of the person signing the substitute statement,²⁵ and 2) the residence, mailing address, and identity by legal name of each inventor as provided in section 1.64(b)(4).

The substitute statement also must contain the penalty acknowledgment that “any willful false statement made in such statement is punishable under section 1001 of title 18 by fine or imprisonment of not more than 5 years, or both.”²⁶ And like the section on oaths/declarations, the section on substitute statements provides that a person may not execute a substitute statement unless that person has reviewed and understands the contents of the application and is aware of the duty to disclose material information.²⁷ The Patent Office provides a form for a substitute statement.²⁸

APPLICATION DATA SHEETS

An application data sheet contains bibliographic data arranged in a format specified by the Patent Office.²⁹ It improves the accuracy of filing receipts and recorded data³⁰ and has been an optional application

element in a design patent application.³¹ The Patent Office provides a form for an application data sheet.³²

The AIA places increased emphasis on the use of application data sheets in three areas. First, claims for foreign priority. A claim for foreign priority formerly was made in an oath or declaration, but now such a claim must be made in an application data sheet.³³ Second, identification of inventors. The old oath/declaration had to identify all inventors. The new oath/declaration need not identify each inventor if the application data sheet indicates the legal name, residence and mailing address of each inventor.³⁴ Third, postponement of oath/declaration filing date. An applicant now may postpone the filing date of an oath or declaration until the application is otherwise in condition for allowance by submitting an application data sheet before examination that properly identifies each inventor.³⁵

Note that either a registered patent practitioner or an individual (non-juristic) applicant must sign the application data sheet.³⁶ An unsigned application data sheet will be treated only as a transmittal letter.³⁷

ASSIGNMENTS

The AIA allows an assignee to file a patent application as the applicant.³⁸ 37 CFR 1.63 provides that an assignment may also serve as an oath or declaration if the assignment includes the information and statements required of an oath/declaration under paragraphs (a) and (b) of section 1.63, contains a willful false statements clause, and a copy of the assignment is properly recorded. The assignment should be recorded no later than the date the issue fee is paid.³⁹ Note that 37 CFR 3.31 states that the assignment cover sheet “must contain a conspicuous indication of an intent to utilize the assignment as the required oath or declaration under Sec. 1.63.”

TIMING

Under the AIA final rules, an oath/declaration need not be filed with the patent application if an application data sheet that properly identifies all inventors is filed with the application and the applicant pays a surcharge fee.⁴⁰ If such an application data sheet is filed and fee paid, the oath/declaration (or substitute statement or assignment/declaration) need not be filed until the application is otherwise in condition for allowance.⁴¹

When the patent application is in a condition for allowance and an oath/declaration has not yet been filed, the patent office will issue a notice of allowability and give the applicant a set period of time to provide the oath/declaration.⁴² Once the oath/declaration (or substitute statement or assignment/declaration) is filed, a notice of allowance will issue.⁴³

REISSUES

Design patents seldom reissue. However, with the growing awareness of portion claiming and the benefits of converting solid lines to broken lines to capture a greater range of potentially infringing designs, reissue design patent applications may increase.

The AIA and final rules revise reissue practice and are intended to make reissue application processing more efficient and to improve the quality of patents.⁴⁴ The changes 1) delete the requirement for a reissue inventor’s oath/declaration to include a statement that all errors arose without any deceptive intent on the applicant’s part, 2) eliminate the requirement for a supplemental inventor’s oath/declaration, 3) require the inventor’s oath/declaration for a reissue application to identify a claim that the application seeks to broaden if the reissue application seeks to enlarge the scope of the patent claims, and 4) clarify that a single claim with both a broadening and a narrowing of the claimed invention is to be treated as a broadening.⁴⁵

FEES

The last mandatory matter when filing a design patent application is to pay the filing fee, search fee, and examination fee. The current fees are listed in 37 CFR 1.16. If the applicant is a small entity, the fees are reduced by half.⁴⁶ If appropriate fees are not paid, the application still will receive a filing date, but the applicant will be notified and given a period of time to pay the fees (and surcharge, if any) to avoid abandonment.⁴⁷ If the applicant has not provided a correspondence address, the applicant has two months from the application filing date to pay the fees (and surcharge, if any) to avoid abandonment.⁴⁸ Note that there are no maintenance fees for design patents.⁴⁹

So in sum, the mandatory items when filing a design patent are the title, figure descriptions, claim, drawings, oath/declaration and fees.⁵⁰ Further, under the AIA, if an applicant claims domestic or foreign

priority, does not want to include the identity of all inventors in the oath/declaration, or wants to postpone filing an oath/declaration, then an application data sheet is mandatory as well.

In future columns we will address optional items that may be included in a design patent application or filed during prosecution. These items include 1) preamble, 2) characteristic feature statement, 3) written description of the design drawings, 4) written description of portions of the design not illustrated in the design drawings, 5) design patent application transmittal form, 6) fee transmittal form, 7) application data sheet (further discussion), 8) petition to make an application special, and 9) expedited examination. Many of these items are recommended and can make the prosecution process more efficient and further strengthen and protect the design patent right.

ENDNOTES

1. U.S. Const. art. I, § 8, cl. 8. Although the first Patent Act enacted in 1790 did not require an applicant oath, see P.J. Federico, Operation of the Patent Act of 1790, 85 J. Pat. & Trademark Off. Soc'y 33 (2003), the Patent Act of 1793 did require an oath. See Patent Act of 1793, Ch. 11, 1 Stat. 318-323 (February 21, 1793).
2. The Patent Act of 1793 required an inventor to "swear or affirm that he does verily believe, that he is the true inventor or discoverer of the art, machine, or improvement, for which he solicits a patent." The 1952 Patent Act required an inventor to swear "that he believes himself to be the original and first inventor"
3. For example, the Patent Act of 1903 required the inventor to swear "he does not know and does not believe that the same [art, machine, manufacture, composition, or improvement] was ever before known or used." 37 CFR 1.46, effective June 1, 1938, required an inventor to swear, *inter alia*, that "to the best of his knowledge and belief the invention has not been in public use or on sale in the United States for more than two years prior to his application"
4. Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (AIA). The AIA contains 37 sections that amend Title 35 United States Code. The AIA expressly states how Title 35 is amended. For example, AIA Sec. 4(a)(1) states in relevant part "[s]ection 115 of title 35, United States Code, is amended to read as follows:"
5. See AIA, section 4(e).
6. See Federal Register, Vol. 77, No. 157, Part VI, pages 48776 - 48826 (August 14, 2012) (37 CFR Parts 1, 3, 5, 10, and 41).
7. See AIA, sec. 3(p).
8. See AIA, sec 4(b) (amending 35 USC § 118). Amended section 118 provides that an applicant may be "[a] person to whom the inventor has assigned or is under an obligation to assign the invention" or "[a] person who otherwise shows sufficient proprietary interest in the matter"
9. See 37 CFR 1.63(a)(1).
10. See 37 CFR 1.63(a)(2).
11. See 37 CFR 1.63(a)(3).
12. See 37 CFR 1.63(a)(4).
13. See 37 CFR 1.63(g).
14. See 37 CFR 1.63(b).
15. See AIA, sec. 4(a)(1); 37 CFR 1.63(a).
16. See 37 CFR 1.55(a)(1). Note that the time periods in this section do not apply to design patents.
17. See AIA, sec. 4(a)(1) (amending 35 USC 115(b)); 37 CFR 1.63(a).
18. See 37 CFR 1.63(c).
19. The PTO Director has the authority to allow an inventor's declaration in lieu of an oath under 35 U.S.C. § 25.
20. This statement also is in 37 CFR 1.68.
21. See Forms SB/01 and SB/01A (for old declarations) and AIA/01 and AIA/08 available at www.uspto.gov.
22. See AIA Inventor's Oath or Declaration Quick Reference Guide, page 3, available at www.uspto.gov (patent office web site).
23. 37 CFR 1.47 has been "removed and reserved" under the AIA.
24. See 37 CFR 1.64(b).
25. See 37 CFR 1.64(b)(2).
26. See 37 CFR 1.64(e).
27. See 37 CFR 1.64(c).
28. See Form AIA/02 available at www.uspto.gov.
29. See 37 CFR 1.76.
30. See Chin, U.S. Design Patent - Do It Yourself, page 36 (2005).
31. See 37 CFR 1.154.
32. See Form AIA/14 available at www.uspto.gov.
33. See 37 CFR 1.55(a)(1). Note that the time periods in this section do not apply to design patents.
34. See 1.63(b).
35. See 37 CFR 1.53(f)(3).
36. See 37 CFR 1.76(e); 37 CFR 1.33(b).
37. See 37 CFR 1.76(e).
38. See AIA, sec 4(b) (amending 35 USC § 118).
39. See 37 CFR 1.63(e)(1)(ii).
40. See 37 CFR 1.53(f)(3).
41. *Id.*
42. See 37 CFR 1.53(f)(3)(ii).
43. *Id.*
44. See Federal Register, Vol. 77, No. 157, Part VI, page 48780 (August 14, 2012).
45. *Id.*
46. *Id.*
47. See 37 CFR 1.53(f)(1).
48. See 37 CFR 1.53(f)(2).
49. See 37 CFR 1.20(e)-(g).
50. It also should be noted that 37 CFR 1.154 states that a design patent application specification should include "cross reference to related applications (unless included in the application data sheet)" and a "statement regarding federally sponsored research or development," if any.